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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,150	02/14/2001	Shlomo Ben-Haim	BIO-125	1041

7590 09/18/2002

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[REDACTED] EXAMINER

RUDDY, DAVID M

ART UNIT	PAPER NUMBER
3739	2

DATE MAILED: 09/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/783,150	BEN-HAIM, SHLOMO
Examiner	Art Unit
David M Ruddy	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 February 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-36 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6) Other:

DETAILED ACTION

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

The preliminary amendment makes reference to claims 1-265, however the examiner only finds claims 1-144 (pages 46-61 of the specification as filed). It is requested that in response to this office action Applicant amends what will be referred to in this office action as "current claims 1-36", to claims 145-180.

Priority

It is noted that this application appears to claim subject matter disclosed in prior copending Application No. 09/111317, filed 7/7/1998. A reference to the prior application must be inserted as the first sentence of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). **Also, the current status of all nonprovisional parent applications referenced should be included.**

If the application is a utility or plant application filed on or after November 29, 2000, any claim for priority must be made during the pendency of the application and

within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2) and (a)(5). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) a surcharge under 37 CFR 1.17(t), and (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231. See the most recent changes to 37 CFR 1.78 in 66 FR 67088 (Dec. 28, 2001).

In the declaration which accompanied this application reference is made to priority which is claimed under 35 U.S.C. 119 to (1) Israeli application 116699 filed 1/8/1996 and (2) international application PCT/IL97/00010 filed 1/8/1997.

The divisional status of the present application brings the effective filing date to 7/7/1998, however the priority benefits afforded by 35 USC 119 can not apply in that the two foreign filling dates are **not** "filed within twelve months from the earliest date on which such foreign" applications were first filed, as required by the statute.

For the same reason Applicant can not claim the priority benefits of provisional application 60/009,769 under 35 USC 119(e).

It appears that Applicant may be able to claim priority benefits (to PCT/IL97/00010) under 35 U.S.C. 365 if the relevant requirements can be met. Further information can be found in MPEP section 1895 and the most recent version of 37 C.F.R. 1.78 (see 66 FR 67088 (Dec. 28, 2001)).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Willis et al (patent #6,216,027). Willis et al. disclose an apparatus and method for mapping the heart comprising the use of ultrasound reference catheters (10) (which include both transmitters and transducers, see figures 3,13, and 18 and column 7, line 1) and "EP" mapping catheters which include an ablation/marking catheter (12), a multi-headed

basket catheter (14), and a linear ablation catheter (16). As disclosed in columns 5-6, the EP catheters may include both ultrasound transducers and transmitters.

As explained in column 5, lines 55-66, the reference ultrasound catheters may be positioned in or out of the heart (possibly in the esophagus as set forth in the specification)

As explained in column 6, lines 24-56, there is disclosed the method of creating a 3D map of heart position data.

In regard to the limitations of claims 8, 18, 26, and 34, Willis et al. disclose impedance measurements in column 14, line 17.

In regard to the limitations of claims 9, 19, 27, and 35, Willis et al. disclose movement measurements in column 18, line 1 – column 19, line 7.

If it is Applicant's intent to assert that the effective filling date of the present application/claims is earlier than patent #6,216,027, the examiner respectfully requests Applicant to set forth the specific chain of priority (including provisional and non-provisional applications and whether the claims meet the priority requirements of 35 U.S.C. 120). Such an assertion is/will be necessary in order to assist the office in making an informed decision as to whether the requirement of 35 U.S.C. 120, that the earlier nonprovisional application discloses the invention of the second application in the manner provided by the first paragraph of 35 U.S.C. 112, is met and whether a substantial portion of all of the earlier nonprovisional application is repeated in the second application in a continuation-in-part situation.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references of Chia et al, Imran, and Panescu et al. all disclose heart mapping systems and methods similar to that of the present application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Ruddy whose telephone number is (703) 308-3595. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-3376 for regular communications and (703) 746-3376 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

DR
August 30, 2002



LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
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